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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/840,104	05/05/2004	Martin Weel	1116-062	9465

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EXAMINER	
BENGZON, GREG C	

ART UNIT	PAPER NUMBER
2144	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/840,104	WEEL, MARTIN	
	Examiner	Art Unit	
	Greg Bengzon	2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 August 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 May 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/28/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This application has been examined. Claims 8-31 are pending. Claims 1-7 are cancelled.

Priority

The effective date of the claims described in this application is May 5, 2004.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 11/28/2007 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgat (US Publication 2002/0173273) in view of Headley (US Publication 2002/0194260).

Spurgat disclosed (re. Claim 8) a system for playing media items, the system comprising:

a playlist server adapted to be communicatively coupled with the Internet, the playlist server having a plurality of playlists stored thereon; (Spurgat-Paragraph 34,*'servers that contain digital audio content and playlists'*)

a content server adapted to be communicatively coupled with the Internet, the content server having a plurality of media items stored thereon; (Spurgat-Paragraph 34,*'servers that contain digital audio content and playlists'*)

a rendering device for playing a media item; (Spurgat,Paragraph 37,*'various digital audio players'*)

a set-top box in communication with the rendering device for facilitating communication of the media item from the content server to the rendering device via the Internet; (Spurgat-Paragraph 48,*' set-top box 107 can propagate this playlist information to any other mobile digital audio players 115 and fixed digital audio players 116'*)

a set-top box operative to obtain one of the plurality of playlists stored on the playlist server, facilitate selection of a media item from the playlist, and direct the set-top box to request the media item from the content server and cause the media item to play on the rendering device.(Spurgat-Paragraph 48)

While Spurgat substantially disclosed the claimed invention Spurgat did not disclose (re. Claim 8) a remote control for controlling the set-top box.

Headley disclosed (re. Claim 8) a remote control for controlling the set-top box; (Headley-Paragraph 24) wherein the remote control is operative to obtain one of the plurality of playlists stored on the playlist server, facilitate selection of a media item from the playlist, and direct the set-top box to request the media item from the content server and cause the media item to play on the rendering device.(Headley-Paragraph 45)

The Examiner notes that Headley and Spurgat have overlapping disclosures regarding directing a set-top box to request the media item from the content server and cause the media item to play on the rendering device.

Spurgat and Headley are analogous art because they present concepts and practices regarding set-top boxes controlling content rendering devices. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Headley into Spurgat. The motivation for said combination would have been to create an audio-video system that a user can program to play multiple media from different audio and video devices in addition to combining this media with information separately from a network such as the Internet. (Headley-Paragraph 9)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> **(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

Claims 9-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgat (US Publication 2002/0173273) in view of Headley (US Publication 2002/0194260) further in view of Edwards (US Patent 6946988).

While Spurgat-Headley substantially disclosed the claimed invention Spurgat-Headley did not disclose (re. Claim 9) wherein the remote control is dockable to the set-top box.

Edwards disclosed (re. Claim 9) wherein the remote control is dockable to the set-top box. (Edwards-Column 3 Lines 5-15,Column 4 Lines 10-30)

Spurgat,Headley and Edwards are analogous art because they present concepts and practices regarding set-top boxes controlling content rendering devices. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Edwards into Spurgat-Headley. The motivation for said combination would have been to enable a remote controller function without the redundancy of including two complete sets of interface elements in an electronic device. (Edwards-Column 1 Lines 50-55)

Spurgat-Headley-Edwards disclosed (re. Claim 10) wherein the remote control is dockable to the set-top box and is in wired communication with the set-top box when docked thereto. (Edwards-Column 3 Lines 5-15,Column 4 Lines 10-30)

Spurgat-Headley-Edwards disclosed (re. Claim 11) wherein the remote control can be used to control the set-top box when docked thereto. (Headley-Paragraph 24)

Spurgat-Headley-Edwards disclosed (re. Claim 12) wherein the remote control comprises a display and a keypad for facilitating control of the set-top box. (Headley-Paragraph 24)

Spurgat-Headley-Edwards disclosed (re. Claim 13) wherein the set-top box comprises a display and a keypad for facilitating control thereof. (Spurgat-Paragraph 46,*'set-top acting as audio gateway'*,Paragraph 68,*'audio gateway with input devices such as keyboard'*)

The Examiner notes that while Spurgat described a set-top box and audio gateway as separate embodiments, Spurgat clearly indicates that a set-top box is an equivalent of the audio gateway. Thus it would have been an obvious variation of Spurgat to include a display and keypad input for the set-top box. (See Amine US Publication 2005/0091693 regarding set-top boxes with display and keypad and docking port)

Spurgat-Headley-Edwards disclosed (re. Claim 14) wherein the rendering device comprises at least one of a stereo system, (Spurgat-Paragraph 71) a television, a digital home system, a DVD player, a stand alone monitor, a computer monitor, a cellular phone, (Spurgat-Paragraph 70) a PDA, a laptop computer, and a speaker.

Spurgat-Headley-Edwards disclosed (re. Claim 15) wherein the media item comprises at least one of a song, (Spurgat-Paragraph 41) a talk, a speech, a comedy sketch, a story, a picture, a video, a movie, and a television show.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16-17,19-26 rejected under 35 U.S.C. 102(e) as being anticipated by Headley (US Publication 2002/0194260)

Headley disclosed (re. Claim 16) a method for providing content, the method comprising: selecting a first media item from a remote control; (Headley-Paragraph 33,' *user selectively combines the various media into a multimedia playlist*') and providing the first media item to a media player via a network. (Headley-Paragraph 32,' *multimedia playlist engine 220 sends commands to different audio and video devices to play different media*')

Headley disclosed (re. Claim 17) wherein the media player further comprises a set-top box operatively coupled to a rendering device (Headley-Paragraph 45) comprising at least one of a stereo system, a television, a digital home system, a DVD player, a stand alone monitor, a computer monitor, a cellular phone, a PDA, a laptop computer, and a speaker.

Headley disclosed (re. Claim 19) wherein the media item comprises at least one of a song, (Headley-Paragraph 10) a talk, a speech, a comedy sketch, a story, a picture, a video, a movie, and a television show.

Headley disclosed (re. Claim 20) a method for obtaining content, comprising:
receiving, at a portable wireless device, a playlist comprising a plurality of identifiers, each of the plurality of identifiers identifying a respective media item; (Headley-Paragraph 10-11)
selecting one of the plurality of identifiers; (Headley-Paragraph 10-11)

requesting a respective media item identified by the selected identifier from a content server; (Headley-Paragraph 35,*'information downloaded from remote database'*)

receiving the requested media item at a control device in communication with the content server and the portable wireless device; and (Headley-Paragraph 35,*'information downloaded from remote database'*)

playing the requested media item at a rendering device. (Headley-Paragraph 31)

Headley disclosed (re. Claim 21) wherein the portable wireless device comprises a remote control operable to affect functionality of the control device. (Headley-Paragraph 24)

Headley disclosed (re. Claim 22) wherein the control device comprises a set-top box.(Headley-Paragraph 24)

Headley disclosed (re. Claim 23) wherein the control device is operatively connected to the rendering device. (Headley-Paragraph 20)

Headley disclosed (re. Claim 24) comprising receiving the playlist from a playlist server. (Headley-Paragraph 35,*'information downloaded from remote database'*)

Headley disclosed (re. Claim 25) wherein the rendering device comprises at least one of a stereo system, (Headley-Paragraph 21) a television, a digital home system, a stand alone monitor, a computer monitor, a cellular phone, a PDA, a laptop computer, and a speaker.

Headley disclosed (re. Claim 26) wherein the identifiers comprise titles of media items. (Headley-Paragraph 33)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 18,27-31 rejected under 35 U.S.C. 103(a) as being unpatentable over Headley (US Publication 2002/0194260) in view of Levitt (US Publication 2002/0151327).

While Headley disclosed (re. Claim 18) receiving a second media item from the network;(Headley-Paragraph 48) Headley did not disclose (re. Claim 18) playing the second media item on the remote control operatively connected to at least one of a speaker and earphones; wherein the remote control is operative to concurrently control the media player via the network.

Levitt disclosed (re. Claim 18) playing the second media item on the remote control operatively connected to at least one of a speaker and earphones; wherein the remote control is operative to concurrently control the media player via the network. (Levitt-Paragraph 70,*'entertainment devices are controlled by PDA'*)

Headley and Levitt are analogous art because they present concepts and practices regarding specifying desired multimedia media content via remote control. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Levitt into Headley. The motivation for said combination would have been to adapt existing intelligent devices for remote control and avoid the high cost of specialized products. (Levitt-Paragraph 10)

Headley disclosed (re. Claim 27) a set-top box for obtaining content from a remote content server, comprising: a wireless interface operative to receive directions from a remote control apparatus; (Headley-Paragraph 45,*'user selectively choose playlist'*)

a network interface operative to facilitate communications with a remote content server; (Headley-Figure 2,Paragraph 35,*'information downloaded from remote database'*)

a rendering-device interface operative to communicate with a rendering device; and (Headley-Figure 2,Paragraph 37',*transmit commands to audio-video devices'*)

wherein the remote control is operative to direct the set-top box (Headley-Paragraph 24) to request a media item associated with an identifier selected from the playlist of identifiers from a remote content server, (Headley-Figure 2,Paragraph 35,*'information downloaded from remote database'*)

and the set-top box is further operative to direct a rendering device to play the media item. (Headley-Figure 2,Paragraph 37',*transmit commands to audio-video devices'*)

While Headley substantially disclosed the claimed invention Headley did not disclose (re. Claim 27) a remote control apparatus having a display and operative to display a playlist of identifiers, each of the identifiers being associated with a respective media item;

Levitt disclosed (re. Claim 27) a remote control apparatus having a display and operative to display a playlist of identifiers, each of the identifiers being associated with a respective media item; (Levitt-Figure 4D, Paragraph 214)

Headley and Levitt are analogous art because they present concepts and practices regarding specifying desired multimedia media content via remote control. At

the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Levitt into Headley. The motivation for said combination would have been to adapt existing intelligent devices for remote control and avoid the high cost of specialized products. (Levitt-Paragraph 10)

Headley-Levitt disclosed (re. Claim 28) wherein the rendering-device interface comprises the network interface. (Headley-Figure 2,Paragraph 37',*transmit commands to audio-video devices'*)

Headley-Levitt disclosed (re. Claim 29) wherein the rendering device comprises at least one of a stereo system, a television, (Headley-Paragraph 21) a digital home system, a DVD player, a stand alone monitor, a computer monitor, a cellular phone, a PDA, a laptop computer, and a speaker.

Headley-Levitt disclosed (re. Claim 30) wherein the remote control apparatus is further operative to receive a list identifying a plurality of playlists, and further operative to select one of the plurality of playlists. (Levitt-Paragraph 84,*'media directory'*, Paragraph 257, Paragraph 149)

Headley-Levitt disclosed (re. Claim 31) wherein the media item comprises at

least one of a song, (Headley-Paragraph 10) a talk, a speech, a comedy sketch, a story, a picture, a video, a movie, and a television show.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to the enclosed PTO-892 form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Greg Bengzon
Patent Examiner, AU 2144